

## REMARKS

The specification has been amended in several locations to delete the word “preferred.” No new matter has been added.

In the second Office Action mailed November 18, 2003, Claims 1-25 were rejected under for alleged obviousness over Kato in view of Parulski et al., and in some instances, in combination with additional references. In paragraph 3 of the second Office Action the examiner once again admits that Kato does not teach selectively generating a first sequence of high resolution still image files or a second sequence of low resolution still image files. However, the examiner again alleges that it would have been obvious to “combine the camera taught by Kato with the generation of low and high resolution images taught by Parulski et al. to make a camera with the limitations of Kato that generates high resolution images for still images and low resolution images to later be used as motion images.” The examiner again alleges that one of ordinary skill “would have been motivated to make such a modification to obtain still images of high quality and motion images with less data such that it is possible to capture the motion images at an adequate frame rate.”

The examiner has effectively admitted that there is no express suggestion in either Kato or Parulski et al. to combine the references as proposed by the examiner. In paragraph 2 of the second Office Action the examiner apparently cites *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992) for the proposition that knowledge generally available to one of ordinary skill in the art can be relied upon for teaching, suggestion or motivation to combine or modify the prior art, even in the absence of some teaching, motivation or suggestion to combine in the prior art references themselves. The examiner then states that “[o]ne of ordinary skill would have been motivated to combine the references and inter-frame code the medium resolution still images to generate a motion video sequence for achieving greater compression in the data, and thus, storing longer video sequences in memory, while retaining higher resolution, quality still images.” The examiner then further states that “[i]t is well-known that it is desirable to process image data so that it requires less storage space while sacrificing as little image quality as possible.” These broad conclusory statements cannot supply the required motivation in light of the lack of reasonable expectation of success in making the

proposed combination. The inter-frame and intra-frame coding of Kato is so complex that a modification thereof that would somehow provide a motion video sequence made up of low resolution image files using the different coding techniques of Parulski et al. would not have had a reasonable chance of success. In order for a proposed modification of a prior art reference to have been considered obvious to one of ordinary skill in the art, there must have been a reasonable expectation of success. *Brown & Williamson Tobacco Corp. V. Philip Morris Inc.*, 229 F.3d 1120 (Fed. Cir. 2000).

Furthermore, as previously argued, even if Kato and Parulski et al. were combined in the manner proposed by the examiner, the end result would still not be the invention of independent Claims 11 and 21 which require *firmware* conversion of the sequence of low resolution of still image files into a motion video sequence. In response to Applicant's latter argument, at the end of paragraph 2 of the second Office Action, the examiner states "[a]s software, hardware, and firmware are all capable of implementing image processing methods, requiring firmware conversion would not render the invention of independent claims 1, 11, 20 and 21 patentably distinct." Respectfully, however, the examiner's position is based on a misunderstanding of the applicable law. Firstly, whether an invention is "patentably distinct" is an issue in restriction practice and double patenting, and has no bearing on obviousness. Secondly, a motivation to combine the teachings of the prior art references requires desirability of making the proposed combination, not merely a tradeoff. A trade off concerns what is feasible, not what is necessarily desirable. Motivation to combine requires the latter. *Winner International Royalty Corp. V. Wang*, 202 F.3d 1340 (Fed. Cir.), *cert denied*, 530 U.S. 1238 (2000).

Accordingly, withdrawal of the obviousness rejection of Claims 11-19 and 21 - 25 for alleged obviousness is requested. Alternatively, the examiner is requested to enter the foregoing amendments since they place this case in better form for appeal.

Respectfully submitted,

 11/14/04

By: Michael H. Jester  
Attorney for Applicant  
Registration No. 28,022